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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-852,313	05-09-2001	Larry Huns	41872-2406/04	4713

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EXAMINER

COLE, ELIZABETH M

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,313

Applicant(s)

HARRIS ET AL.

Examiner

Elizabeth M. Cole

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 1-43, 48, 50, 51, 56, 58, 59, 64, 66 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-46, 47, 49, 52-55, 57, 60-63, 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(A) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 44-46, 47, 49, 52-55, 57, 60-63, 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 581,274 to Kamata et al in view of EP 436,729 to Yamato et al. Kamata et al discloses a textile material which may be formed into a garment and which is placed in a bath with microcapsules which contain a fragrance. The microcapsules are taken up by the fabric. See page 7, line 51 – page 8, line 9. Kamata differs from the claimed invention because Kamata does not teach employing a binder to further fix the microcapsules to the textile fabric and does not teach incorporating a moisturizer into the fabric. Kamata further does not teach that the textile is hosiery. Yamato et al teaches that a small amount of a binder may be incorporated into the mixture comprising microcapsules which are to be applied to a fabric. Yamato teaches that the binder helps to adhere the microcapsules to the fabric. See page 6, lines 36-49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a binder in applying the microcapsules to the fabric of Kamata. One of ordinary skill in the art would have been motivated to employ a binder by the teaching of Yamato that this would further enhance the bonding of the microcapsules and the fabric. Yamato teaches that microcapsules which are applied to a fabric such as a garment may further comprise moisturizers and other skin conditioning agents in addition to fragrant components. Yamato further teaches that suitable garments to which such microcapsules could be applied include hosiery. See p. 6, lines 3-31 and p. 4, lines 5-10 and p. 5, lines 13-18. Therefore, it would have been obvious to

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have incorporated a moisturizer, (i.e., a humidity preserving agent), in addition to a fragrance in the microcapsules of Kamata, motivated by the expectation that this would further enhance the fabric of Kamata by making it moisturizing in addition to being fragrant. It further would have been obvious to have applied the microcapsules to hosiery as taught by Yamato. One of ordinary skill in the art would have been motivated to apply the microcapsules to hosiery because Yamato teaches that since hosiery is in direct contact with skin, the fragrant, moisturizing microcapsules would be most effective.

With regard to the process limitations and the order of steps claimed, product by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product - by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 173 USPQ 685, 688 (CCPA 1972). Therefore, the burden

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is shifted to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

3. Applicant's arguments filed 3/25/04 have been fully considered but they are not persuasive. Applicant argues that neither reference teaches the particular process steps in the particular order. However, as set forth above, with regard to process limitations in a product claim, the burden is shifted to Applicant to come forward with evidence establishing an unobvious difference between the prior art product and the instant claims. Applicant also argues that Yamato teaches away from the claimed invention because it teaches pre-treating the fabric or fibers to prevent the permeation of binders into the fibers to avoid adversely affecting the hand of the fabric. However, Kamata et al teaches that the microcapsules should be dispersed into the solution and applied to the textile so that the textile takes up all of the solution including the microcapsules. See page 7, lines 56 o page 8, line 12. Therefore, Kamata et al teaches that the microcapsules should be fully adsorbed by the fabric.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (703) 872-9306.



Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c